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In re Application of SHUSTER et al
U.S. Application No.: 10/571,017
PCT Application No.: PCT/US2004/029025
Int. Filing Date: 07 September 2004
Priority Date Claimed: 05 September 2003
Attorney Docket No.: 25791.306.04
For: EXPANDABLE TUBULAR

DECISION

This is in response to applicant's "Petition Under 37 C.F.R. § 1.182" filed 28 August 2007.

BACKGROUND

On 07 September 2004, applicant filed international application PCT/US2004/029025, which claimed priority of an earlier United States application filed 05 September 2003. The thirty-month period for paying the basic national fee in the United States expired on 06 March 2006 (05 March 2006 was a Sunday).

On 03 March 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and a substitute specification.

On 18 December 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that a properly executed oath or declaration must be filed.

On 12 January 2007, applicant filed an executed declaration.

On 02 May 2007, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that the declaration filed 12 January 2007 is incomplete.

On 30 May 2007, applicant filed an executed declaration.

On 07 June 2007, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that the declaration filed 30 May 2007 is improper.

On 12 July 2007, applicant filed an executed declaration.

On 28 August 2007, applicant filed the present petition under 37 CFR 1.182.

DISCUSSION

A review of international application PCT/US2004/029025 reveals that the application contained 812 claims. A proper amendment reducing the number of claims was never submitted in the international application.

MPEP 1893.01(c) states in relevant part,

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492**>(d)-(e)< and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492*>(f)<. A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608. (Emphasis added.)

In the present case, the initial national stage submission on 03 March 2006 did not include a proper preliminary amendment. However, it is apparent from the papers filed 03 March 2006 that applicant sought to reduce the number of claims for examination at the time of national stage entry. Specifically, the substitute specification contained a listing of 27 claims, rather than the 812 claims contained in the international application. Furthermore, the transmittal letter (Form PTO-1390) contained a payment calculation based on the presence of 27 claims as opposed to 812 claims. A proper preliminary amendment was filed with the present petition, reducing the total number of claims to 27. Because of applicant's intent to reduce the number of claims for examination and because the fees due for the presence of 812 claims at the time of the initial national stage submission would not be remotely commensurate with number of claims that remain for examination, justice in the present case requires waiver of the requirement that a preliminary amendment must accompany the initial national stage papers in order to reduce the number of claims to be considered in calculating extra claim fees.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is GRANTED.

Applicant is advised that the declaration filed 12 July 2007 is improper. Specifically, the declaration is an impermissible composite declaration which consists of one each of pages 1 and 3 and three of page 2. In addition, page 3 appears to have been transmitted by facsimile. Where individual declarations are executed, they must be submitted as individual documents

rather than combined into one declaration. An appropriate declaration submission would include either: (1) a single complete declaration which has been presented to and executed by all of the inventors or (2) multiple complete declarations, wherein each inventor has executed at least one of the complete declarations. The declaration is further defective because it contains a non-initialed, non-dated alteration on the third of page 2. See 37 CFR 1.52(c)(1) and MPEP 602.01.

Because the time limit for response to the Notification of Defective Response cannot be extended and because the extendable period for response to the Notification of Missing Requirements has expired, the application is ABANDONED.

The application is being forwarded to the DO/EO/US for processing in accordance with this decision, including preparation and mailing of a Notification of Abandonment (Form PCT/DO/EO/909), which should indicate that the application is abandoned for failure to file a proper response to the Notification of Missing Requirements mailed 18 December 2006.

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